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In re Application of: UNDERBRINK et al.
Application No.: 10/570,833
PCT No.: PCT/US2004/028926
Int. Filing Date: 02 September 2004
Priority Date: 02 September 2003
Attorney Docket No: ST02042USU2 (281-US-U2)
For: SIGNAL PROCESSING SYSTEM FOR
SATELLITE POSITIONING SIGNALS

DECISION ON PETITION TO
REVIVE UNDER
37 C.F.R. 1.137 (b)

This decision is in response to applicants' "PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)" filed in the United States Patent and Trademark Office (USPTO) on 12 May 2009. The submission is also being treated as a renewed petition under 37 CFR 1.497 (d).

BACKGROUND

On 02 September 2004, applicant filed international application PCT/US2004/028926, which claimed priority to an earlier US application filed 02 September 2003. Accordingly, the thirty month period for paying the basic national fee in the United States expired at midnight 02 March 2006.

On 01 March 2006, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1).

On 31 August 2006, the DO/EO/USA mailed a Notice of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 02 April 2007, Applicant sent in a petition for extension of time and response to the Notification of Missing Requirements.

On 20 August 2007, the DO/EO/US mailed a Notification of Abandonment.

On 20 August 2007, the DO/EO/US mailed a Notice of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.495.

On 20 September 2007, Applicant filed a petition under 37 CFR 1.181 to withdraw the Holding of Abandonment. The decision of 08 November 2007 stated that the petition was granted, the notification of Abandonment mailed on 20 August 2007 was vacated and the Notice of Acceptance of Application under 35 U.S.C. 371 mailed 20 August 2007 was vacated.

On 29 May 2008, A Notification of Defective Response (Form PCT/DO/EO/916) was mailed with a one month response period.

On 30 June 2008, applicant filed a petition under 37 CFR 1.48(a) which was treated by the DO/EO/US under 37 CFR 1.497(d). Included with the 30 June 2008 response was an unsigned statement requesting withdrawal of Robert Tso as a co-inventor and an indication that a signed statement by Robert Tso would follow in a supplemental response.

On 01 July 2008 a supplemental response with a statement signed by Robert Tso and a substitute combined declaration and power of attorney signed by inventor Nicholas Vantalon was filed with the DO/EO/US.

On 03 September 2008, a petition decision DISMISSING applicant's 30 June 2008 petition was issued.

On 12 May 2009, applicant filed the present Petition for the Revival of an International Application for Patent Designating the US Abandoned Unintentionally Under 37 CFR 1.137 (b) considered herein.

DISCUSSION

I. Renewed Petition under 37 CFR 1.497(d)

37 CFR 1.497(d) states,

If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT **Rule 92bis** subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different

from the inventive entity identified in any such oath or declaration, applicant must submit:

(1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;

(2) The processing fee set forth in § 1.17(i); and

(3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter); and

(4) Any new oath or declaration required by paragraph (f) of this section.

With regard to item (1) above, the requisite statement has been provided.

With regard to item (2) above, the requisite processing fee has been provided.

With regard to item (3) above, the original petition stated that SiRF Technology, Inc. ("SiRF") is the assignee of the present application and that SiRF consents to the correction of inventorship. Although the person signing the statement of consent states that he is the attorney of record, 37 CFR 3.73 (b)(2)(i) specifically requires a statement that the person signing the submission is authorized to act on behalf of the assignee.

With regard to item (4) above, a new declaration under 37 CFR 1.497(f) is not required.

II. Petition under 37 CFR 1.137 (b)

A petition under 37 CFR 1.137(b) requesting that the application be revived the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional" and (4) any terminal disclaimer and fee pursuant to 37 CFR 1.137(c) (where required).

Regarding item (1), the required reply has not been received. Specifically, a grantable petition under 37 CFR 1.497(d) has not been filed as discussed in § I above. Furthermore, proper declarations executed by inventors Underbrink, Falk, Gronemeyer and Protic have not been submitted. As stated in the decision mailed 08 November 2007, it is not proper to submit a composite declaration which is created by assembling different copies of the same declaration page (i.e. page 3 of declaration filed 02 April 2007) into a single declaration.

Regarding item (2), the petition fee has been received.

Regarding item (3), the petition includes a statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" and satisfies the requirement.

Regarding item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.

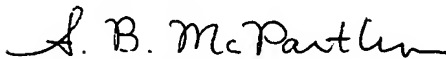
CONCLUSION

For the reasons listed in § I above, applicants' petition under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

For the reasons detailed in § II above, applicants' petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petitions is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450., with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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